

REMARKS

Claims 62 and 101 have been amended by incorporating subject matter of claims 28, 79, 104 and/or 108 into them so as to require the presence of a silicone component consisting of one or more non-volatile silicone compound(s) which are compatible with the non-volatile hydrocarbon-based oil and which are selected from the group consisting of polydimethylsiloxanes, fluorosilicones, silicone resins, silicone gums, polydimethylsiloxanes comprising alkyl or phenyl groups, phenyl trimethicones, phenyl dimethicones, phenyl trimethylsiloxydiphenylsiloxanes, diphenyl dimethicones, diphenyl methyldiphenyltrisiloxanes, 2-phenylethyl trimethylsiloxysilicates, and mixtures thereof.

Accordingly, claims 28, 79, 104 and 108 have been canceled.

Also, the dependencies of claims 105, 106, 109 and 110 have been changed, and the remaining claims have been amended to conform to these claim amendments and cancellations.

Claims 2-27, 31-42, 44-51, 53-58, 60-78, 81-95 and 101-103, 105-107 and 109-112 are currently pending, although claims 53-57, 60 and 61 have been withdrawn from consideration. Because the withdrawn claims ultimately depend from non-withdrawn claims, Applicant respectfully requests rejoinder of the withdrawn claims pursuant to MPEP § 821.04.

The Office Action rejected the pending claims under 35 U.S.C. §103 as obvious over EP 0548694 (“Nojima”) in view of U.S. patent 5,738,841 (“Mellul”) alone or in combination with U.S. patent 5,690,918 (“Jacks”) or JP 63119412 (“JP 412”). In making these rejections, the Office Action asserted that Nojima discloses transfer-resistant compositions which contain silicone compounds and hydrocarbon

oils but which lack volatile oils and that Mellul teaches compatibility of silicone compounds with octyldodecyl neopentanoate, so it would have been obvious to use octyldodecyl neopentanoate as a hydrocarbon oil in Nojima's compositions. In view of the following remarks, Applicant respectfully requests reconsideration and withdrawal of these rejections.

Nojima requires the presence of alkoxyated silicone compounds. In sharp contrast, all of the pending claims exclude the presence of alkoxyated silicone compounds. That is, the claims require the presence of a silicone component which does not include alkoxyated silicone compounds. Because Nojima requires the presence of alkoxyated silicone compounds, Nojima cannot teach or suggest the claimed silicone component, meaning that Nojima cannot teach or suggest the claimed invention.

Mellul cannot compensate for Nojima's deficiencies. First, Mellul provides no motivation to modify Nojima's compositions to yield the invention compositions. As noted above, Nojima requires the presence of alkoxyated silicones. Mellul, on the other hand, is directed to "surprisingly" homogenous mixtures of octyldodecyl neopentanoate and "at least one silicone-containing compound which may be chosen from silicone oils, gums and/or waxes." (Col. 2, lines 48-49). Mellul neither teaches nor suggests that her silicones could be alkoxyated and, in fact, teaches away from such alkoxyated silicones by identifying only non-alkoxyated silicones as being suitable for combination with octyldodecyl neopentanoate. (Col. 2, line 49 through col. 3, line 6). One skilled in the art, following the teachings of both of these references, would not have been motivated to combine them given the highly specific nature of their disclosures: Nojima relates only to alkoxyated silicones, while Mellul

relates to “surprisingly” homogeneous compositions containing non-alkoxylated silicones. Given the specificity of their disclosures, nothing in either of these references would have suggested that non-alkoxylated silicones could be used in Nojima’s compositions or that alkoxylated silicones could be used in Mellul’s compositions to yield a “surprisingly” homogeneous composition.

Second, Mellul does not relate to transfer-resistant compositions, let alone transfer-resistant lipsticks. Rather, Mellul discloses non-transfer-resistant compositions containing 0% inert particulate phase or 48% or more inert particulate phase,¹ and teaches that volatile silicone oils are interchangeable with non-volatile silicone compounds. (See, col. 2, line 51). One skilled in the art, seeking to produce a composition addressing appearance and sensation problems associated with transfer-resistant compositions, particularly lipsticks, would not be motivated by Mellul to selectively combine the required ingredients in the required proportions with the expectation that the resulting composition would be a transfer-resistant composition, particularly a transfer-resistant composition having desirable properties such as not having a matte appearance or a sensation of dryness, tautness and/or discomfort.

Neither Jacks nor JP 412 suggests modifying Nojima’s compositions to yield the claimed invention. Jacks requires the presence of too much volatile oil, so it cannot teach or suggest the claimed compositions having little or no volatile oil. JP 412, which is cited merely for its disclosure relating to 12-hydroxystearic acids, cannot compensate for Nojima’s deficiencies as well.

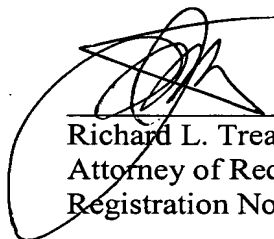
In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

Applicant believes that the present application is in condition for allowance.

Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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¹ In this regard, Applicant notes that pigments do not constitute fillers/inert particulate phase. (See, specification at pages 20 and 21; Mellul at col. 2, line 43).